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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

MAMMEN, N

ART UNIT

PAPER NUMBER

3671

DATE MAILED:

10/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/336,204

Applicant(s)

Beck, III

Examiner

Nathan Mammen

Group Art Unit

3671



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-41 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☒ Claim(s) 12-22 and 34-41 is/are allowed.

☒ Claim(s) 1, 2, 23, 26, and 27 is/are rejected.

☒ Claim(s) 3-11, 24, 25, and 28-33 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly, Jr. et al. (U.S. Patent 3,682,258).

The Kelly '258 patent discloses a piloted drill bit comprising a barrel portion (12, 14), with a downhole hammer drill (D) disposed substantially within the barrel portion near the barrel portion periphery, and a pilot portion (50) axially aligned with the barrel portion and extending distally therefrom to pilot the barrel portion along the pilot shaft.

3. Claims 1, 2, 23, 26, 27 rejected under 35 U.S.C. 102(b) as being anticipated by SU 590445.

The SU 590445 patent discloses a piloted drill barrel for excavating a shaft in hard rock. The drill barrel comprises a barrel portion (1) having a downhole hammer (2) disposed substantially within the barrel portion near the barrel portion's periphery for excavating a collar around a pilot shaft. The drill also comprises a pilot portion (11) axially aligned with the barrel portion and extending distally therefrom to pilot the barrel portion along the pilot shaft during

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excavation of a larger diameter shaft, the pilot portion further comprising an auger flight to convey cuttings out of the pilot shaft.

Regarding claims 26 and 27: In view of the structure disclosed by the SU 590445 patent, the method of excavating a relatively large diameter shaft would have been inherent since it is the normal and logical manner in which the device would be used.

Allowable Subject Matter

4. Claims 3-11, 24, 25, 28-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 12-22, 34-41 are allowed.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Mammen whose telephone number is (703) 306-5959. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at (703) 308-3870. The fax number for this Group is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-1113.



Thomas B. Will
Supervisory Patent Examiner
Group 3600

NSM
9/22/00

Nathan S. Mammen